

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Alberson, et al.  
Serial No.: 10/091,838  
Filing Date: March 6, 2002  
Group Art Unit: 3679  
Examiner: Ryan M. Flandro  
Confirmation No. 8562  
Notice of Allowance Mailed: September 9, 2004  
Title: HYBRID ENERGY ABSORBING REUSABLE TERMINAL

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

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I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Willie Jiles

Willie Jiles

Date: March 14, 2005

**RESPONSE TO NOTICE OF WITHDRAWAL FROM ISSUE**

Applicants hereby respond to the Notice of Withdrawal from Issue mailed by the USPTO ("the Patent Office") on December 9, 2004.

Applicants received an Issue Notification dated November 25, 2004 for this application providing a projected patent number of 6,830,237 and a projected issue date of December 12, 2004. This application was withdrawn from issue on December 9, 2004, just before its projected issue date, in response to a Request for Interference filed in a Reissue Application of U.S. Pat. 6,623,204 ("the Buehler Application"). That request for interference seeks an interference between the Buehler Application and this present application.

The Request for Interference argues that U.S. Patent 6,461,076 ("the Stephens Patent") — which was made of record in the prosecution of the present application — shows the elements of the claims of the present application, and that the Buehler Application shows the same elements because the Buehler Application is a reissue of a divisional application of the Stephens Application. In doing so, the Request for Interference makes much of the fact that at one point during prosecution of the present application some claims that were pending at the time were rejected over the Stephens Application. This emphasis may have caused the Patent Office to overlook certain pertinent facts when deciding to withdraw the present application from issue:

- The present application was explicitly determined patentable over the Stephens Patent by the Patent Office: "The Examiner confirms that the claims in the instant application distinguish over the cited prior art (including the Stephens reference) for reasons indicated . . . ". Notice of Allowance and Issue Fee Due, mailed September 9, 2004, p.2 *Examiner's Reasons for Allowance*.
- Stephens was considered on the merits by the Patent Office and was not considered unavailable as prior art due to a swear-behind affidavit. ("The Affidavit submitted 15 April 2003 . . . was not considered in the most recent Office Action and the claims are allowable for the reasons indicated in the May 6th Office action). Notice of Allowance and Issue Fee Due, mailed September 9, 2004, p.2 *Examiner's Reasons for Allowance*.
- The Patent Office would have to reverse its earlier explicit decision that the present application was patentable over the Stephens Patent in order to declare an interference.

That the Patent Office explicitly considered the Stephens Patent and determined that it did not show the elements of the allowed claims may well have been overlooked in deciding to withdraw the present application from issue. This is likely, given the emphasis in the Request for Interference on the rejection in the early stages of prosecution of the then currently-pending claims over the Stephens reference and the filing of the associated swear-

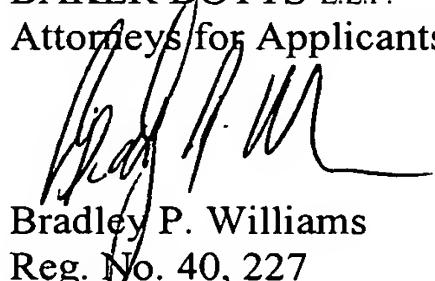
behind affidavit. And this possible oversight would be understandable given the expedited nature of the decision to withdraw the present application just days before issuance.

**CONCLUSION**

In light of the above, Applicants respectfully request that the Patent Office consider the above-listed facts and reconsider the decision to withdraw the present application from issue. This would be particularly appropriate in this case to avoid encouraging the use of the interference procedures as a post-allowance opposition proceeding — it can be seen that this Request for Interference essentially requests the Patent Office to reconsider an Examiner's patentability determination, something the Interference procedures were not intended to allow.

Respectfully submitted,

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Date: March 14, 2004

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